

C. Remarks

The claims are 1-15 and 17-26, with claims 1, 6, 10 and 20 being independent. Claims 1-5, 10-14 and 20-24 have been withdrawn from consideration as being directed to a non-elected invention. Claims 6 and 15 have been amended to clarify the invention. Support for the amendment may be found, *inter alia*, in the specification at page 13, line 24, through page 14, line 13, and in Figs. 4 and 5. Claims 19 and 25 have been amended to reflect the changes in claim 15. Claim 26 has been amended for clarification to address the formal issues raised by the Examiner. Support for this change may be found, for example, in step S2 in accordance with Fig. 4. No new matter has been added. Reconsideration of the present claims is expressly requested.

Claim 26 stands rejected under 35 U.S.C. § 112, first and second paragraphs, as allegedly failing to comply with the written description requirement and being allegedly indefinite. Specifically, the Examiner alleged that it is unclear how the DNA microarray is being identified and that the specification does not disclose such identification.

Applicant has amended claim 26, which is related to step S2 in Fig. 4, for clarification. In view of this amendment, the above rejections should be withdrawn.

Claims 6, 7, 15, 16, 18 and 25 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from U.S. Patent No. 5,876,926 (Beecham) in view of U.S. Patent No. 6,187,450 B1 (Staub) and 6,905,827 B2 (Wohlgemuth). Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Beecham, Staub and

Wohlgemuth in view of U.S. Patent No. 6,362,004 B1 (Noblett). Claims 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Beecham, Staub and Wohlgemuth in view of U.S. Patent No. 6,021,393 (Honda). Claims 26 stands rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Beecham, Staub and Wohlgemuth in view of U.S. Patent Application Publication No. 2001/0012537 A1 (Anderson). The grounds of rejection are respectfully traversed.

Prior to addressing the merits of rejection, Applicant would like to briefly review some of the features and advantages of the presently claimed invention. That invention, in pertinent part, is related to a method for using a DNA microarray to both analyze a specimen collected from a subject and to identify the subject. To achieve this goal, the DNA microarray contains at least two DNA probe groups. The first DNA probe group can be used to identify the subject. The second DNA probe group can be used to test a specimen from the subject. A pattern obtained from the hybridization pattern in the first DNA probe group is analyzed to identify the subject. A pattern obtained from the hybridization pattern in the second DNA probe group is used to generate test information.

In particular, a first personal identification code (or identification number) is obtained from a hybridization pattern. This identification code (or identification number) is compared with a second personal identification code (or identification number). For example, the personal identification code or number is obtained by processing a hybridization pattern and converting the pattern into a numerical value. As a result, according to the present invention, both the identification of the test subject and a test for a disease can be performed using the same sample (specimen) at the same time.

Beecham is directed to a method and an apparatus for obtaining biometric data from a test subject for identification and testing a sample obtained from the test subject. However, as acknowledged by the Examiner, Beecham fails to disclose or suggest performing these two processes using a single microarray.

Staub is directed to various methods for genetically identifying infants. While one of these methods utilizes a microarray, there is still no disclosure or suggestion of a combined use of the microarray as claimed. Furthermore, Staub does not disclose or suggest comparing the first identification code or number acquired from a DNA microarray with the second identification code or number stored in a database.

Wohlgemuth is directed to diagnosing and monitoring an autoimmune or chronic inflammatory disease by detecting expression levels of at least one gene. However, like Beecham and Staub, this reference does not disclose or suggest comparing the first identification code or number acquired from a DNA microarray with the second identification code or number stored in a database.

Noblett, Honda and Anderson cannot cure the deficiencies of Beecham, Staub and Wohlgemuth. Noblett was cited by the Examiner for a teaching of fiducial marks on a microarray. Honda was cited for a teaching of portable memory cards carried by patients. Anderson was cited for a teaching of using identifiers on microarrays. However, even if assumed, *arguendo*, that these references contain the alleged teachings, they still lack the same disclosure that is missing in Beecham, Staub and Wohlgemuth, i.e., comparing the first identification code or number acquired from a DNA microarray with the second identification code or number stored in a database.

In conclusion, Applicant respectfully submits that the cited references, whether considered separately or in any combination, fail to disclose or suggest the presently claimed elements.

Wherefore, withdrawal of the outstanding rejection and expedient passage to issue are respectfully requested.

This Amendment should be entered, because it places the case in allowable form. Alternatively, it places the case in better form for a possible appeal.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

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